

REMARKS

Claims 1-29 are pending. Claims 1-8, 14-17, 22, 23, and 29 are rejected. Claims 1, 14, and 22 are amended herein. Claims 3, 23, and 29 are canceled herein.

Rejection of Claims 1-2, 4-6, 8, 22, 23 and 29 Under 35 U.S.C. §102.

Claims 1-2, 4-6, 8, 22, 23 and 29 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 2,593,760 issued to *James*. Claims 1 and 22 has been amended herein to include a tension roller adjustably mounted to each arm, an adjustment screw connected to the tension rollers, and an adjustment nut to increase and decrease the distance between the tension rollers to increase and decrease the tension of the blade. The MPEP states,

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

MPEP § 2131.

James does not disclose each and every element of Claims 1 or 22. As acknowledged by the Examiner (Office Action 03/25/2009, p. 3), *James* does not disclose a tension device having tension rollers, an adjustment screw, and an adjustment nut. Rather, *James* discloses a single bolt that forces a platform 20 and a single drive pulley 28 rearwardly. Furthermore, the Examiner acknowledges that “*James* doesn’t show a housing defining a handle.”

In addition, *James* does not disclose a Y-shaped frame with an “open throat” as in Claim 22. In contrast, *James* requires “a pair of complementary parts 10 and 11 together forming a generally triangular unit whose inner edges are spaced to provide a central passageway 12.” The presence of the complementary parts 10 and 11 do not define an open throat, and would greatly hinder the performance of Applicant’s claimed invention. As discussed in the Applicant’s specification, the open throat defined by the relative positions between the arms, the handle, and the blade “provide a degree of stability and control of the coping saw 1 that allows the operator to precisely and accurately control the cutting surface 9 along curves, notches, and protrusions, including those in coping.”

Since *James* fails to describe each and every limitation of the Claims, Applicant respectfully submits that Claims 1 and 22 are not anticipated by *James*.

Rejection of Claims 3, 7, and 14-17 Under 35 U.S.C. §103.

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatenable over *James*.
Claim 3 has been cancelled herein

Claims 7, and 14-17 are rejected under 35 U.S.C. §103(a) as being unpatenable over *James* in view of U.S. Pat. No. 5,388,334 issued to *Halsey* (hereafter referred to as “*Halsey*”)

As partly discussed above, independent Claims 1 has been amended herein to include a tension roller adjustably mounted to each arm, an adjustment screw

connected to the tension rollers, and an adjustment nut to increase and decrease the distance between the tension rollers to increase and decrease the tension of the blade. Furthermore, none of the cited references disclose a Y-shaped frame with the open throat of Claim 14. As discussed above, the open throat defined by the relative positions between the arms, the handle, and the blade provide a degree of stability and control of the coping saw.

Therefore, Applicant submits that the prior art references do not contain all the claim limitations of Claims 1 and 14, as required by the Manual of Patent Examining Procedure ("MPEP") to establish a *prima facie* case of obviousness. Moreover, the references of record, neither individually, or in combination, teach or suggest the claimed inventions.

Applicant respectfully traverses the Examiner's rejection of those Claims under 35 U.S.C. § 103. Specifically, Applicant believes the Examiner has not established a *prima facie* case of obviousness as required under patent law and in accordance with the Manual of Patent Examining Procedure ("MPEP"). The MPEP states,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 706.02(j) (emphasis added).

The Examiner has not shown that all elements of any of claims 1 and 14 are found in *James*, or in the combination of *James* and *Halsey*. In fact, as noted above, there are at least one element specified in independent Claims 1 and 14 that are not suggested, disclosed, or claimed at all in *James*. Additionally, none of these missing elements are disclosed or suggested by *Halsey*.

The Examiner asserts that, "Because these two systems were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute adjustment screw 32, block 14 and plate 34 for an adjustment screw connected to rollers and a nut in order to quickly tension the blade." However, the Examiner relies on his own personal knowledge and the general knowledge in the prior art to support his obviousness rejection. The Examiner's ability to use such personal and general knowledge is subject to 37 CFR §1.104(d)(2), which states:

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." See 37 CFR §1.104(d)(2).

Therefore, Applicant requests under 37 CFR §1.107(b) that the Examiner provide an affidavit in conformance with §1.104(d)(2). Applicant points out that general skill in the art will rarely operate to supply missing knowledge or prior art to reach an obvious judgment. As stated by the Federal Circuit:

“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” See *W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Sang Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

It is noted that independent Claim 1 forms the basis for dependent Claim 7 and independent Claim 14 forms the basis for dependent Claims 15-17. Because a dependant claim cannot be obvious if the independent claim from which it depends is not obvious, all claims depending from Claims 1 and 14 must also be found nonobvious.

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 7 and 14-17 as being obvious under 35 U.S.C. § 103.

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Conclusion.

Applicant believes the above analysis and the amendments made herein overcome all of the Examiner's objections and rejections and that the claims are in condition for allowance. Therefore, applicant submits that claims 1-2, 4-8, 14-17, 22, and 24 constitute allowable subject matter and should be favorably considered by the Examiner. The Applicant urges the Examiner to issue a timely Notice of Allowance for those claims.

The Commissioner is hereby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17, which may be required by this paper to Deposit Account 162201.

Respectfully submitted,

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/Scott A. Smith/
Scott Anthony Smith, Registration No. 46,067
POLSTER, LIEDER, WOODRUFF & LUCCHESI, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, MO 63131-3615
Telephone: (314) 238-2400
Facsimile: (314) 238-2401